

**DETAILED ACTION**

This is a first action following a request for continued examination. Claims 1-3, 6-11, 16, 17, 19, 21-33, 36-51 and new claim 53 are pending. Claims 4, 5, 12-15, 18, 20, 34, 35 and 52 are cancelled. Claims 2, 6, 7, 32, 33 and 36-49 are withdrawn from consideration. Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50, 51 and 53 are examined.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 January 2009 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3635

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

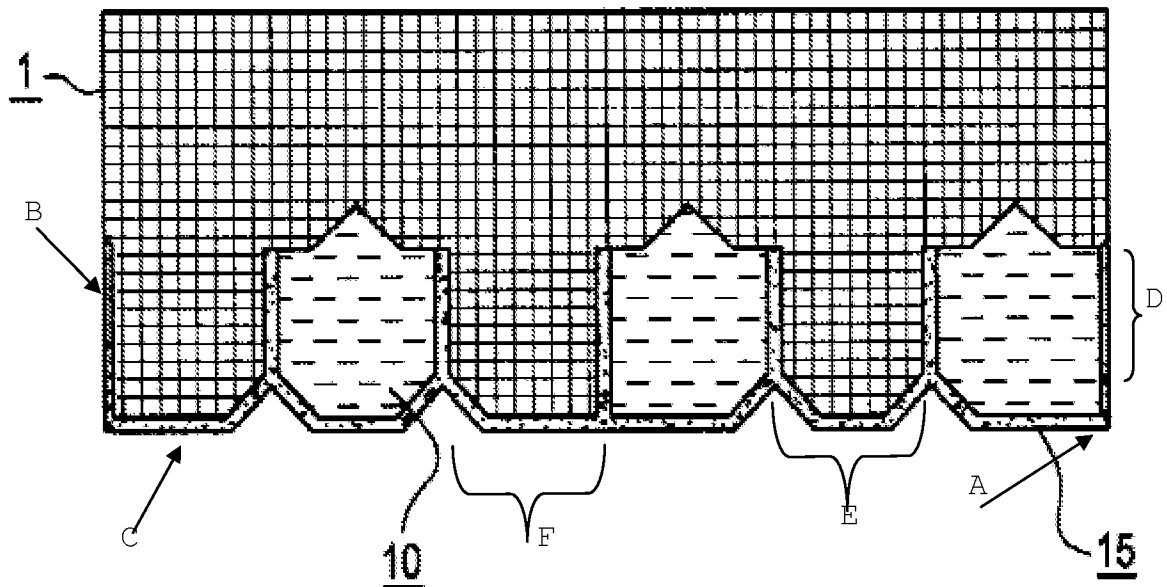
**Claims 1, 3, 8-11, 16, 17, 19, 21-31, 50 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc et al. (U.S. Patent No. 6,105,329), in view of Stahl (U.S. Patent No. 6,305,138) and Elliott (U.S. Patent No. 6,421,976).

Regarding Claims 1, Bondoc discloses a shingle (Figure 5, generally) with an anterior layer (1) and a posterior layer (15), the anterior layer having a head lap (Figure 1, element 3) and a butt (Figure 1, element 4), an alignment notch (Figure 1, element 6), the shingle having outermost bottom left and right corners, and at least one of the bottom outermost corners (element "A" from attached Figure 5 from Bondoc, below) corresponds to the alignment notch, the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64). The phrase "corresponds to the alignment notch" provides no further structural limitation as to how the corner and notch relate. The definition of *correspond* is "to be consistent,

Art Unit: 3635

compatible or harmonious" (*Webster's II Dictionary*, third edition: Houghton Mifflin, 2005.) By using this definition and the broadest reasonable interpretation, the bottom outermost corner(s) correspond with the notch in that they are compatible with each other.

Bondoc does not disclose the limitations of the shadow band as claimed. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott and Stahl with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention. Further, to have the shadow band a third shade would be obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947).



**Figure 5 from Bondoc**

Regarding Claim 3, the notch (6) has a triangle shape and a corner corresponds to a side of the triangle (element "A" from attached Figure 5 from Bondoc, above) and rejection of claim 1 for clarification of "corresponds".

Regarding Claims 8 and 29, Bondoc discloses a shingle with at least one layer (per Claim 29), a posterior layer (15) with a head lap (element "B" from attached Figure 5 from Bondoc, above) and tabs (element "C" from attached Figure 5 from Bondoc, above), an anterior layer positioned on the posterior layer (1),

Art Unit: 3635

an anterior head lap (Figure 1, element 3), an alignment notch (Figure 1, element 6) and at least one anterior tab (Figure 1, element 2) positioned on the posterior tabs, and the anterior layer and posterior layer form a shingle, the shingle has outermost bottom left and right corners, and at least one of the outermost corners that corresponds to the alignment notch (see "A" above: see rejection of Claim 1 above for argument addressing *corresponds*), the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64). The phrases "formed from...length", per Claim 29, line 1, are statements of the process of making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Bondoc does not disclose the limitations of the shadow band as claimed. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design

Art Unit: 3635

choice to use the shading patterns in Elliott and Stahl with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention. Further, to have the shadow band a third shade would be obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice because matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. See M.P.E.P. §2144.04(I) citing *In re Seid*, 161 F.2d 229 (CCPA 1947).

Regarding Claim 9, the alignment notch (Bondoc: 6) is triangular shape.

Regarding Claim 10, there are four posterior tabs (see Bondoc Figure 4, area proximate element 20).

Regarding Claim 11, the anterior and posterior tabs have first and second breadths respectively, and the second breadth is greater than the first breadth (see Figure 5 generally).

Regarding Claim 16, the posterior tabs (element C above) extend beyond the anterior tab (2; see Figure 5, generally).

Regarding Claims 17, 19 and 21 the anterior head lap (Figure 9, area proximate element 40, per Claims 17, 19, 21) extends beyond the posterior head lap (Figure 9, area proximate element 44, per Claim 17) the anterior head lap edge aligns to a

Art Unit: 3635

posterior head lap edge (Figure 9, element 48, see area proximate element 42 where dotted line represents how the two headlaps may align, per Claim 19) and the posterior head lap extends beyond the anterior head lap (element "D" from attached Figure 5 from Bondoc, above, where the posterior head lap extends beyond the anterior headlap, per Claim 21).

Regarding Claims 22 and 23, Bondoc discloses two anterior tabs (Figure 8, element 60 per Claim 22) and three anterior tabs (Figure 8, element 60 per Claim 23).

Regarding Claim 24, Bondoc discloses the claimed invention except the spacing of the posterior tabs. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to make the shingle in Bondoc with these dimensions because Applicant failed to state a criticality for this spacing and the shingle in Bondoc is capable of being made in such a manner. See MPEP 2144.04(IV)(A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding Claim 25, the anterior tab (2) has a corner that corresponds to the alignment notch (see area proximate element A from attached Figure 5 above).

Regarding Claim 26, the posterior tabs (element "C" from attached Figure 5 from Bondoc, above) have corners (area proximate "A" above) that correspond to the alignment notch (6).

Regarding Claim 27, the anterior tab is positioned substantially centered on the posterior tab (element "E" from attached Figure 5 from Bondoc, above).

Regarding Claim 28, the anterior tab is positioned offset from the posterior tab (element "F" from attached Figure 5 from Bondoc, above).

Regarding Claim 30, the shingle has an anterior layer (1) and a posterior layer (15).

Regarding Claim 31, the phrase "formed from...length" per line 1 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim. The limitations are considered product-by-process; therefore, determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not



Art Unit: 3635

depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). Further, It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding Claim 50, Bondoc does not disclose a method of installing a shingle by affixing a shingle to the roofing area, affixing another course to the roof by aligning the cut corner of one course with the alignment notch of the previous course, and repeating the above steps until the roof is completely covered. It would have been obvious at the time the invention

Art Unit: 3635

was made to a person having ordinary skill in the art to install the shingle in Bondoc in this manner because the shingle in Bondoc has the alignment notch (6) and the shingle has outermost bottom left and right corners and the corner corresponds to the notch (see rejection of Claim 1 above for clarification), and the edge corner and alignment notch correspond to act as an alignment means.

Regarding Claim 51, only the method of installing the shingle is claimed. The phrase, "formed from...length" line 2 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in the claimed manner, then it meets the claim. The limitations are considered product-by-process; therefore, determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985).

**Claim 53** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc.

Regarding Claim 53, Bondoc discloses a roofing material comprising two roofing shingles each having an anterior layer and a posterior layer (1 and 15, respectively) that are of a substantially equal length (as shown in Fig. 5). The applicant should respectfully note that only the roofing material is claimed. The limitations provided in lines 3-11 are drawn to a method of making the shingle, including the cutting cylinder. These limitations are considered a product-by-process and determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). Further, to change the shape of the apparatus would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have this limitation because a configuration of an invention is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed subject matter was

Art Unit: 3635

significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP §2144.04.

Bondoc does not disclose a plurality of the shingles as claimed, however, it would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

### ***Response to Arguments***

3. Applicant's arguments filed 09 January 2009 have been fully considered but they are not persuasive.

#### **Limitation of "corresponds":**

Applicant's arguments regarding the examiner's interpretation of "corresponds" with respect to the "bottom outermost corner" of the shingle "with the alignment notch" are respectfully not persuasive. Applicant provided an excerpt from the specification (page 15) to indicate the definition of "corresponds". Upon reading the specification, the examiner believes it further supports the examiner's position that the outermost corner in the prior art cited corresponds to the alignment notch. For example, applicant claims "an alignment

Art Unit: 3635

notch" (claim 1, line 3) with no further structural limitation. Applicant then claims the bottom right corner corresponds to the notch (line 6). Applicant's claims do not provide limitations drawn to define the shape of the corner, only that it "corresponds" to the notch. Applicant's specification states, "the corners can be cropped or can be formed by right, obtuse or acute angles to correspond to the alignment notch" (Spec. page 15). Without further limitation to define the shape of the alignment notch and the shape of the edge, the examiner maintains that the edges correspond for the reasons stated above and cited in the rejection.

**Limitation of the shading of the shingles:**

The examiner maintains that to add granules for shading would be obvious for aesthetic purposes. While noting that the function of the shading is to provide a specific visual effect, the examiner maintains that this visual effect is the very definition of an aesthetic feature. The obviousness of the rejection meets the claimed limitations because the shading is located in the same locations as claimed, and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

Art Unit: 3635

otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As a result, the examiner maintains that the rejection is proper.

**Rejection of Claim 53:**

The examiner maintains that the rejection was proper as a matter of product by process; determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). Applicant claims in the preamble "a roofing material", which is what the examiner considers in the examination process. Respectfully, the preamble is directed to an apparatus, not the process of making the apparatus. The method of making the panel is not provided patentable weight.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William

Art Unit: 3635

V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./

Examiner, Art Unit 3635

/Basil Katcheves/

Primary Examiner, Art Unit 3635